

REMARKS

By this amendment, claims 33, 35, and 37, the specification, and the drawings have been amended and claims 39-50 are added to place this application in condition for allowance. Currently, claims 33-50 are before the Examiner for consideration on their merits.

In response to the objection to the drawings, formal drawings are submitted herewith with a separate letter to the draftsman. The Examiner should also note that Figure 2 is revised by the inclusion of the information recording medium and its outputs in connection with the information filtering unit 50. No new matter is introduced by this amendment, since the specification supports this arrangement and entry is respectfully requested.

The specification has been checked as requested by the Examiner, and the changes have been made as detailed above.

Applicants note the Examiner's comments regarding the claim for priority under 35 USC 119(a-d), and the lack of the filing of a certified copy of the priority document. However, since this application claims priority from another US application under 35 USC 120, Applicants have referenced the parent application as having the certified copies of the priority applications, and there is no need to resubmit them in this application (see the transmittal sheet filed with the application). The Examiner's acknowledgement that the certified copies of the priority documents are located in the parent application serial number 08/707,765 is respectfully requested.

Turning to the IDS issue, Applicants first would like the Examiner to reconsider his position regarding the Kawai et al. article and JP 06 243173. Since the date is included in the citation of Kawai and an abstract of the Japanese patent application is in English, Applicants are unsure as to the basis for refusing to consider this prior art. Applicants contend that this art is properly cited, and the Examiner should return a corrected PTO-1449 with the proper initialing for Kawai and JP 06 243174. In light of this, Ojala, Chen, and Nomura are the only documents missing a date on the PTO-1449. To rectify this situation, another IDS is hereby submitted with the appropriate fee so that these

references are properly considered by the Examiner, and listed on the front face of the patent. The new PTO-1449 lists the Kawai and JP 06 243173 documents as well so that the Examiner can initial them for convenience sake rather than returning the first PTO-1449.

The Examiner has also raised four main issues regarding the claims under 35 §§ 101, 103, and 112, and double patenting of the obviousness-type. These rejections are addressed under their respective headings.

35 USC 101

In this rejection, the Examiner alleges that claim 33 is non-statutory since it does not involve the technological arts. It is submitted that the amendment to claim 33 overcomes the rejection under 35 USC 101 since claim 33 defines the use of a computer. New independent claim 42 also includes reference to a computer, and this claim is also directed to statutory subject matter. By the amendment to claim 33, the rejection has been effectively overcome, and should be withdrawn.

Obviousness-Type Double Patenting

In the Office Action, the Examiner alleges that the claims are obvious variants over the claims of the parent patent U. S. Patent No. 6,647,378 (the '378 patent). Applicants respectfully disagree with the Examiner. In the '378 patent, after a learning operation is performed to assign each prediction value predicting a user's necessity degree to the corresponding keyword, effective keywords are selected and preferentially registered according to the prediction values of the keywords. Therefore, the number of registered keywords can be suppressed so as to register the keywords in a register having a limited memory capacity.

In contrast, in the present invention, after the prediction value of each keyword predicting a user's necessity degree is calculated, the prediction value predicting a user's necessity degree is assigned to the corresponding keyword for each keyword. Therefore, pieces of received information can be rearranged in order of necessity of the user. The concept detailed in the instant application is not an obvious variant from that which is claimed in the '378 patent, and

therefore, there is no basis to make an obviousness-type double patenting rejection, and the rejection in this regard must be withdrawn.

35 USC 112

In this rejection, the Examiner alleges that the claims are not enabled. However, no more is said in this rejection other than that, and Applicants contend that the rejection is flawed since it does not identify in the least what is the basis for such a contention. Without such a basis, Applicants are unable to respond to this rejection. Moreover, Applicant contends that the invention as now claimed is enabled by the specification and that the rejection should be withdrawn.

35 USC 102

Lastly, the Examiner has rejected all claims based on anticipation and United States Patent No. 5,297,042 to Morita. In Morita, each of relationship values is defined as the degree of a relationship between keywords. Further, each of importance values is defined as the degree of importance of the keyword in each document. The relationship values and the importance values are set in the associative retrieval unit 2, see column 2, lines 48-53. The associative retrieval unit 2 calculates a relevance value of each document on the basis of the (inputted) weight data, the relationship values and the importance values. The controller 3 sorts all the documents in downward sequential order of the relevance value (column 2, lines 58-67).

Further, in Morita, when the user inputs expected values T_i corresponding to the relevance values, link factors W corresponding to the relationship values and link factors S corresponding to the importance values are changed on the basis of the expected values.

In the present invention, keywords are attached to each piece of information data, a user's necessity or non-necessity of each piece of information data is inputted, a prediction value of each keyword predicting a user's necessity degree is calculated according to the user's necessities and non-necessities for the pieces of information data, and the prediction values are assigned to the corresponding keywords respectively. Therefore, the prediction

value of each keyword is determined according to the user's necessities and non-necessities for the pieces of first information data. This feature of the invention is specifically recited in claim 33, as amended. Since Morita does not teach a method wherein a user's necessity or a user's non-necessity for each piece of information is inputted, and then a prediction value is calculated according to the inputted user's necessity or the user's non-necessity, it cannot be used to reject the claims under 35 USC 102. Morita just does not teach each and every limitation of claim 33.

Since anticipation has not been established, the Examiner can only rely on 35 USC 103 to further reject claims 33-38. However, in order to rely on obviousness, the Examiner must have some motivation to modify Morita so as to arrive at the instant invention. However, there is no motivation to do so. Any contention that it would be obvious to modify Morita so as to arrive at the invention is the application of hindsight, a practice prohibited in patent law. Since there is no basis to conclude obviousness, the Examiner has no choice but to indicate that claims 33-38 are patentably distinguishable from Morita.

New Claims 39-50

Claims 39-41 are also in condition for allowance by reason of their dependency on claim 33.

Claim 42 is an apparatus claim which parallels claim 33 but uses means plus function format, wherein the function of each means corresponds to the claimed processing steps of claim 33. Since claim 42 requires an inputting means and calculating means that utilizes the user's necessity and user's non-necessities as inputted, claim 42 is also distinguishable from Morita for the same reasons as claim 33. Therefore, claim 42 and its dependent claims 43-50 are also in condition for allowance.

Since claims 42-50 parallels claim 33-41 in function, claims 42-50 should be properly examined as part of the instant application, and should not be subject to a restriction requirement. The issues before the Examiner are the same for claims 42-50 as for claims 33-41.

Summary

By this amendment, each and every issue raised in the Office Action has been addressed and overcome. The specification and drawings have been amended as required by the Examiner. Claim 33 has been revised to overcome the rejections based on 35 USC 101 and 102/103 so that claims 33-41 are patentable. New claims 42-50 parallel claims 33-41 and are also in condition for allowance for this reason.

Accordingly, the Examiner is respectfully requested to examine this application in light of this amendment, and promptly pass claims 33-50 onto issuance.

If the Examiner believes that an interview would expedite allowance of this application, the Examiner is invited to telephone the undersigned to resolve any outstanding issues.

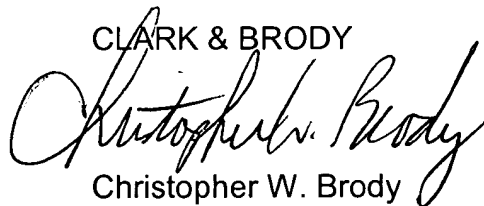
The above constitutes a complete response to all issues raised in the December 31, 2003 Office Action.

Again, reconsideration and allowance of this application is respectfully solicited.

A petition is made for a one month extension of time, and a check in the amount of \$110.00 is included herewith to cover the cost of the petition. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully requested,

CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", is written over the printed name.

Christopher W. Brody
Reg. No. 33,613

1750 K Street, NW, Suite 600
Washington, DC 20006
Telephone: 202-835-1111
Facsimile: 202-835-1755
Docket No.: 041-1894D
Date: April 29, 2004